

Claim Objections

Applicant acknowledges the indication that claims 6 and 16 contain allowable subject matter. Applicant believes, however, that all pending claims are allowable for the reasons discussed below.

Rejections Under 35 U.S.C. §103

Claims 1-5, 8, 10-15, and 18 were rejected under 35 U.S.C. §103(a) as unpatentable over *Lytle et al* (U.S. Patent Pub. No. 2002/0188683) in view of *Powers* (U.S. Patent Pub. No. 2001/0034849) and further in view of *Scheussler et al* (U.S. Patent No. 6,366,950). Applicant respectfully traverses this rejection.

Claims 1, 10, and 11 are directed to methods and an apparatus for email transmission. These claims recite, among other elements, adding the sending address to the receiving address list when the sending address does not match the unique email address registered by the registration means.

The *Lytle* patent discloses a process of creating a new email address. The *Powers* patent teaches that a proof copy of an email message is emailed back to the sender so that the sender may authenticate her identity.

In the rejection, the Office Action acknowledges that the combination of the *Lytle* patent and the *Powers* patent fails to teach or suggest adding a sending address to a receiving address list when the sending address does not match a registered unique email address. The Office Action alleges that the *Scheussler* patent remedies this deficiency.

The *Scheussler* patent discloses a system in which a client computer on a network has a unique identification number that is embedded within a processor. When a client computer generates a message to be sent over the network, a client

module attaches the identification number of the client computer to the generated message prior to transmission. A recipient computer receives the message, extracts the received I.D. number, and compares this number with a list of ID numbers stored in the data base. When the received ID number matches one of the stored ID numbers, the recipient computer accepts the email as being transmitted from an authorized computer. On the other hand, when the received ID number fails to match one of the stored ID numbers, the received message will be blocked or rejected (see Abstract, col. 6, lines 49-56).

Contrary to the position taken in the Office Action, Applicant submits that the *Scheussler* patent fails to teach or suggest adding the sending address to the receiving address list as recited in independent claims 1, 10, and 18. Particularly, Applicant submits that the teachings of the *Powers* and *Scheussler* patents cannot be combined without improperly relying on Applicant's own disclosure.

As noted above, the *Scheussler* patent discloses a system that prevents a user from receiving email messages from unauthorized senders. In other words, the *Scheussler* patent describes a system that protects a user on the recipient side of an email transmission. The *Scheussler* patent fails to discuss that any security operations are performed with respect to the transmission of an email message. The *Powers* patent, however, teaches a security mechanism preventing forged correspondences from being sent over a network. In other words, the *Powers* patent protects a user on the sender side of an email transmission. The *Powers* patent fails to discuss that any security operations are performed with respect to the receipt of an email other than the proof copy that is sent to the sender.

The Office Action alleges that one of ordinary skill in the art will be motivated to combine these teachings so that the actual owner of an email address may be informed that her email address has been used without her authorization (see Office Action, pg. 5). Applicant, however, has failed to find a motivation as such that is either taught or suggested by any of the applied references. Applicant suspects this lack of motivation is related to the fact that the *Scheussler* patent and the *Powers* patent are taken from different perspectives of an email transmission. Because the *Scheussler* patent and the *Powers* patent are directed at two different perspectives of an email transmission, any rationale that either reference would have for protecting a user would be directly related to the perspective or side of the transmission to which it is concerned. The *Lytle* patent fails to provide any further insight as to how or why these references can be combined to achieve the claimed results. For at least these reasons, Applicant submits that there is no motivation to combine the references, and thus a *prima facie* case of obviousness has not been established.

In sum, the *Lytle*, *Powers*, and *Scheussler* patents either singularly or combined fail to teach or suggest every element recited in independent claims 1, 10, and 18. Specifically, the aforementioned references fail to teach or suggest at least adding a sending address to a receiving address when the sending address does not match a unique email address but is registered by registration means, as recited in the aforementioned claims. Accordingly, a *prima facie* case of obviousness has not been established.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981,

180 USPQ 580 (CCPA 1974). Moreover, obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. V. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). For at least the above reasons, Applicant requests that the rejection under 35 U.S.C. §103 be withdrawn, and claims 1, 10, and 11, and their associated dependent claims be allowed.

Claims 9 and 19 were rejected under 35 U.S.C. §103(a) as unpatentable over the *Lytle* publication in view of the *Powers* publication, the *Scheussler* patent, and further in view of *Soroker et al* (U.S. Patent Pub. No. 2002/0112010). Applicant respectfully traverses this rejection.

In a previous response, Applicant addressed the rejection of claims 9 and 19 by asserting that the applied references, and in particular, the *Soroker* publication fails to disclose displaying the receiving address and sending address as recited in the aforementioned claims.

In the current rejection, the Office Action alleges that because the *Soroker* publication displays a list of all recipients, one of ordinary skill in the art would have found it obvious to incorporate this feature into the device resulting from the combination of the *Lytle* publication, the *Powers* publication, and the *Scheussler* patent. Moreover, the Office Action asserts that one of ordinary skill in the art would be motivated to combine the aforementioned references so that an authorized user may be deterred from sending an illicit email based on the fact that the user sees that the inputted sender address is automatically incorporated into the recipient list (see Office Action, pg. 8). Although Applicant fails to find any teaching or suggestion

in the applied references as such, Applicant notes that the motivation as asserted in the Office Action is strikingly similar to a passage in Applicant's own disclosure (see Specification, pg. 11, lines 1-4). Applicant believes that this revelation provides further evidence that the applied references lack the requisite teaching or suggestion to combine, and that the motivation alleged in the Office Action is improperly derived from Applicant's own disclosure. For at least these reasons, Applicant submits that a *prima facie* case of obviousness has not been established, and requests the allowance of claims 9 and 19 and the withdrawal of this rejection.

Claims 20 and 21 were rejected under 35 U.S.C. §103(a) as unpatentable over the *Lytle* publication in view of the *Powers* publication, and further in view of the *Soroker* publication. Applicant respectfully traverses this rejection.

Each of independent claims 20 and 21 recite, among other elements, displaying the receiving address and sending address contained in the receiving address list.

The Office Action acknowledges that the *Lytle* and *Powers* publications fail to teach or suggest the aforementioned claim element. The Office Action alleges that the *Soroker* publication remedies this deficiency. As discussed above, however, neither the *Lytle*, the *Powers* nor the *Soroker* publications teach or suggest a motivation to combine their respective features to achieve the claimed results. In fact, the motivation to combine as asserted in the Office Action appears to be derived from a passage in Applicant's own disclosure. For at least these reasons, Applicant believes that the Office Action has improperly relied on hindsight reasoning to reject these claims. Thus, a *prima facie* case of obviousness has not been

established. Applicant requests, therefore, that the rejection of claims 20 and 21 under 35 U.S.C. §103 be withdrawn, and these claims be allowed.

Conclusion

Based on at least the foregoing remarks, Applicant submits that claims 1-6, 8-16, and 18-21 are allowable, and this application is in condition for allowance. Accordingly, Applicant requests a favorable examination and consideration of this application. In the event that the application can be placed in even better form, Applicant requests that the undersigned attorney be contacted at the number provided below.

Respectfully submitted,

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